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ROBERT J. DRISCOLL, J.D., PH.D.
PRESIDENT AND CHIEF EXECUTIVE OFFICER
1900 SOUTH NORFOLK STREET, SUITE 105
SAN MATEO CA 94403

MAILED

OCT 14 2010

In re Application of : **OFFICE OF PETITIONS**
Wiles et al. :
Application Number: 10/016993 : ON PETITION
Filing Date: 12/13/2001 :
Attorney Docket Number: R-948 :
:

This is a decision on the petition filed on July 28, 2004, to withdraw the holding of abandonment.

The Office apologizes for the delay in responding to the present petition and regrets any inconvenience to petitioners.

The petition is **DISMISSED**.

This application became abandoned on March 6, 2004, for failure to timely file a reply to the non-final Office action mailed on December 5, 2003, which set a three (3)-month shortened statutory period for reply. Notice of Abandonment was mailed July 14, 2004.

In the present petition, petitioners request that the Office withdraw the holding of abandonment due to non-receipt of the non-final Office action mailed on December 5, 2003.

Petitioners state, via, the petition signed by registered patent practitioner Kelly L. Quast, that a thorough search of the file jacket and docket record was made, and that the Office action was not received. A copy of the docket report and file jacket is enclosed. Petitioners further aver that "in July 2004, Applicants' mailing address changed. Applicants believe that the

mailing address in connection with all applications filed by Deltagen, Inc., had been properly updated after their move. However, in some applications the address was not properly changed. As a result, other applications associated with Deltagen, Inc. may have outstanding Office actions that were not received."

A review of the record indicates:

1. On December 13, 2001, the application was filed, with 740 Bay Road, Redwood City, CA 94063 listed as the address on the transmittal letter.
2. On March 18, 2002, an executed declaration was filed, listing Deltagen, Inc., 740 Bay Road, Redwood City, CA 94063 as the address of the attorneys of record.
3. On December 5, 2003, the non-final Office action was mailed to: Deltagen, Inc., 740 Bay Road, Redwood City CA 94063.
4. On April 12, 2004, a Change of Correspondence Address was filed, stating the correspondence address should be changed to the address associated with Customer No. 26619 or Deltagen, Inc., 1031 Bing St., San Carlos CA 94070.
5. On June 17, 2004, an associate Power of Attorney and Change of Address Request was filed, stating the address should be changed to: **Deltagen, Inc., 1031 Bing Street, San Carlos, CA 94070.** (emphasis in original)

MPEP 711.03(c) states, in pertinent part:

In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

(emphasis added)

It is noted that in another application filed by the same applicants, No. 10/180,936, an Office action was mailed on November 12, 2003 to the address of 740 Bay Road, Redwood City, CA 94063, but that the Office action in Application No. 10/180,936 was returned as undeliverable because applicant had relocated to 1031 Bing St., San Carlos CA 94070, but failed to timely apprise the Office of the change of correspondence address. Moreover, it is noted that in Application No. 10/015,543, another application filed by the same applicants as the subject application, an Office action was mailed on November 7, 2003, to the 740 Bay Road, Redwood City, CA 94063 address, but was not received.

Accordingly, the showing of record is that: (a) petitioners have a history of not receiving Office actions, and (b) the Office action was not received because petitioners were no longer receiving mail at the address of record.

MPEP 601.03 states that where an attorney or agent of record (or applicant, if he or she is prosecuting the application *pro se*) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address (including ZIP Code). See 37 CFR 11.11.

Petitioner must verify that they were, in fact, receiving mail at the correspondence address listed in the Office action mailed on December 5, 2003 at the time that the Office action was mailed, and for a reasonable time thereafter.

Accordingly, as the showing of record is insufficient to warrant withdrawal of the holding of abandonment at this time, the petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. This time period is not extendable.¹ The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181."

In the alternative, petitioners may wish to file a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application.

¹ See 37 CFR 1.181(f).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

A reply may also be filed via EFS-Web.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.


Douglas I. Wood
Senior Petitions Attorney
Office of Petitions